

REMARKS/ARGUMENTS

Applicant has amended Claims 5 and 16. No new matter was added by these amendments. Claims 3-17 remain in this application, and Applicant requests reconsideration of this application in view of the above amendments and these remarks and arguments.

Claim Objections

In the Office Action Summary page, the Examiner indicated that Claim 8 is objected to. However, on page 5 of the Office Action that Examiner appears to reject Claim 8 based on the combined teachings of Dent (USPN 5,903,835) and Cummins, et al. (USPN 4,887,299). Applicant requests that the Examiner clarify the issue as to whether Claim 8 is allowable in the next Office Action. In any event, Applicant submits that Claim 8 is allowable by virtue of its dependence on an allowable base claim, Claim 5 for the reasons set forth below.

Claim Rejections 35 USC §103

The Examiner has rejected Claims 3-7, 11-13 and 16-17 under 35 U.S.C. 103(a) as being unpatentable over Dent in view of Cummins, et al. Applicant traverses these rejections. To establish a *prima facie* case of obviousness, and hence to find Claims 3-7, 11-13 and 16-17 unpatentable under 35 U.S.C. § 103(a) over the combination of Dent and Cummins, et al., three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not be based upon applicant's disclosure. MPEP at § 2142.

In this case, at a minimum the combined teachings of Dent and Cummins, et al. fail to teach or suggest all of the claim limitations recited in independent Claims 5 and 16. More particularly, Claim 5 now recites a “fixed attenuator . . . to attenuate at a fixed attenuation level a received signal . . . to below a clip point threshold of said analogue to digital converter”, and Claim 16 now recites “attenuating at a fixed attenuation level a signal . . . to below a clip point threshold of the analogue to digital converter”. The Examiner admits at page 3 of the Office Action that Dent does not disclose the fixed attenuator of Claim 5 that provides the attenuation function defined in Claims 5 and 16, but contends that language at col. 12, line 51 to col. 13, line 10 of Cummins, et al. teaches a fixed attenuator. However the attenuator disclosed in the Cummins, et al. reference is not the *fixed* attenuator providing functionality as defined in Claims 5 and 16.

The attenuator disclosed in Cummins, et al. is designed to adjust an input signal level based on the range of the A to D converter (col. 13, lines 7-8). However, this attenuator does not attenuate *at a fixed attenuation level* a signal to below a clip point threshold of the A to D converter as required by the language of Claims 5 and 16. Conversely, the input signal level is adjusted by an attenuator that has an *adjustable attenuation setting* (col. 13, lines 1-3). More specifically, if the input signal is above a certain level, the attenuation is increased by 6 dB, but if the signal is below a certain level for a given number of samples then the attenuation is decreased by 6dB (col. 13, lines 3-7).

Therefore, since limitations recited in Claims 5 and 16 are missing from the combined teachings of Dent and Cummins, et al. a rejection of Claims 3-7, 11-13 and 16-17 under 35 U.S.C. 103(a) based on these references is improper and should be withdrawn.

The Examiner has further rejected: Claims 9-10 under 35 U.S.C. 103(a) as being unpatentable over Dent, in view of Cummins, et al. as applied to Claim 5 above, and further in view of Bazarjani, et al. (USPN 6,005,506); and Claims 14-15 under 35 U.S.C. 103(a) as being unpatentable over Dent, in view of Cummins, et al. as applied to Claim 5 above, and further in view of Ostman, et al. (USPN 6,069,923). Applicants have set forth a number of limitations that are recited in Claim 5 and included by dependency in Claims 9-10 and 14-

15, which are not disclosed in either Dent or Cummins, et al. Applicant further submits that these limitations are also not disclosed in Bazarjani, et al. and Ostman, et al. Therefore, since limitations are missing from the Dent, Cummins, et al., Bazarjani, et al. and Ostman, et al. references, a rejection of Claims 9-10 and 14-15 under 35 U.S.C. § 103(a) is improper and should be withdrawn

Applicant believes that the subject application, as amended, is in condition for allowance. Such action is earnestly solicited by the Applicant.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicant's attorney at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection. Further, Applicant reserves the right to present in future submissions any argument not presented in the present paper.

Please charge any fees that may be due to Deposit Account 502117, Motorola, Inc.

Respectfully submitted,

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